



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of: <i>Libman</i>	)	Art Unit: 3622
	)	
Serial No.: 09/592,086	)	Examiner: Alvarez, Raquel
	)	
Filed: June 12, 2000	)	<b>REPLY UNDER 37 C.F.R. 1.116 –</b>
	)	<b>EXPEDITED PROCEDURE</b>
For: <i>Apparatus for Preparing Client</i>	)	
<i>Communications Involving Financial Products and</i>	)	
<i>Services</i>	)	

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**REQUEST TO WITHDRAW FINALITY OF OFFICE ACTION/  
REQUEST FOR RECONSIDERATION**

**Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450**

Dear Sir:

Applicant respectfully requests withdrawal of the finality of the Office Action of May 5, 2005 in the present proceedings under MPEP Rule 706.07(d). The basis for this request is that the Examiner has apparently (perhaps inadvertently) failed to consider and/or explain how certain limitations in the presented claims are met or made obvious by the cited reference (De Lapa – US Patent No. 5,822,735). This is abundantly plain and indisputable as explained in more detail below.

While this may be a simple oversight, at this point Applicant submits that the prosecution record is substantially incomplete, and thus the “finality” of the Office Action is premature. The withdrawal is required by the MPEP which states:

**706.07(d) Final Rejection, Withdrawal of, Premature**

If, on request by applicant for reconsideration, the primary examiner finds the final rejection to have been premature, **he or she should withdraw the finality of the rejection. ...**

Without further detailed information from the Examiner - specifically addressing the deficiencies in the De Lapa reference presented by the Applicant vis-à-vis the present claims

- Applicant submits that the record for appeal will also be similarly deficient, and the substance of any subsequent proceedings substantially compromised. Finally, it is plainly contrary to the CFR and MPEP for the PTO to deny the Applicant an opportunity to understand – prior to any appeal - the nature and arguments of any rejections during prosecution.

Accordingly, at this time Applicant submits that the proper course of conduct is for the Examiner to withdraw the final Office Action, and issue a new, non-final office action explaining in sufficient detail how & where the De Lapa reference teaches or suggests the following limitation currently presented in the claims:

“...wherein steps (1), (2) and (3) are performed for each entity in said entity set and for each financial product and financial service in said financial product/service set, **such that each financial product and financial service in said financial product/service set is considered for possible offering to each entity in said entity set...**” (emphasis added)

Thus the PTO is respectfully invited to supplement the record, and when/if the Examiner provides such information, Applicants will then be in a position to address the full merits of the present case. Without getting into the merits of the same at this point, Applicants note that the De Lapa reference teachings appear to be woefully deficient on this point, and, in fact, appears to teach away from the invention. Consequently, the Applicant believes that the Examiner will appreciate – on more closer inspection - that the De Lapa reference is lacking in this respect.

In the alternative, if the PTO elects not to present such evidence, Applicant submits that the rejection should be reconsidered, and the case passed on to allowance. From a threshold perspective - and as can be seen below from the lack of a rejection of such limitation in the claim - the PTO has clearly not met its burden under 35 USC §103 to demonstrate that the reference in fact makes obvious the claim. Without such evidence, there can be no sustainable rejection of the claim, and it would be unfair and wasteful to require Applicant to present such deficiency unnecessarily in a costly and time consuming appeal. Moreover given that the prosecution of this case has now exceeded 5 years, it is particularly important that the record be accurate.

A more detailed analysis follows. Please note that none of the present discussion is intended or should be interpreted to waive any prior evidence, argument or traverse of record.

## **ANALYSIS - DISCUSSION**

One of the key criteria needed to establish *prima facie* obviousness of a claimed invention is that **all the claim limitations must be taught or suggested by the prior art.** *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). *See, e.g.*, MPEP 2143.03; 706.02(j).

In this instance, the Examiner has failed to explain how certain limitations in the claim are met by the reference. On this basis, the present Office Action is deficient, and a determination of finality is premature and should be withdrawn.

## **REVIEW OF PROSECUTION HISTORY:**

1. To wit, in an amendment filed May 15, 2003, the Applicant amended the claims as follows:

***In the Claims:***

Please substitute claim 1 with the following claim 1:

1. A method of automatically preparing a communication pertaining to a financial product or a financial service for an entity, the method comprising:
  - (1) automatically determining whether to offer a financial product or a financial service to said entity;
  - (2) if it is determined to offer a financial product or a financial service to said entity, then using decision information to automatically determine variable information, the variable information for inclusion in the communication for said entity; and

(3) automatically generating the communication, the communication including an offering to said entity for a financial product or a financial service, the communication having a communication format, wherein said communication format comprises at least one portion that accommodates the variable information, the generating step including incorporating the variable information into said at least one portion of the communication, wherein the variable information is related to said offering, and wherein the variable information comprises at least one of financial product information, financial service information, offer information, and entity information;

wherein steps (1), (2), and (3) are performed using one or more data processing devices, and are performed within an automated process.

At this time, therefore, the claims did not include the limitation noted above<sup>1</sup> and which is the focus of this request.

2. Following this amendment, the Examiner rejected the claim in an Office Action mailed November 11, 2003, using the following rationale:

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<sup>1</sup> To reiterate: "...wherein steps (1), (2) and (3) are performed for each entity in said entity set and for each financial product and financial service in said financial product/service set, **such that each financial product and financial service in said financial product/service set is considered for possible offering to each entity in said entity set...**" (emphasis added)

4. Claims 1-158 are rejected under 35 U.S.C. 103(a) as being unpatentable over De Lapa et al. (5,822,735 hereinafter De Lapa).

With respect to claims 1, 53-58, 64, 116-121, 127-131, 143-148, 150-151, 153, 154-158 De Lapa teaches a method of automatically preparing a communication pertaining to a product for an entity (Abstract). (1) Automatically determining whether to offer a product to said entity (figure 6);

(2) if it is determined to offer a product to said entity, then using decision information to automatically determine variable information, the variable information in the communication for said entity (see Figures 2 and 6);

(3) and automatically generating the communication, the communication including an offering to said entity for a product, the communication having communication format, wherein said communication format comprises at least one portion that accommodates the variable information, the generating step including incorporating the variable information into said at least one portion of the communication, wherein the variable

information is related to said offering, and wherein the variable information comprises at least one of product information (see Figure 2).

The steps being performed using data processing devices and within an automated process (i.e. the steps of determining and generating are performed via a computerized system)(see Figure 4).

De Lapa does not specifically teach that the offer is for a financial product or financial service. Official notice is taken that it is old and well known to offer financial products or financial services to customers. For example, bank customers are often offer additional services such as car loans, vacation loans, mortgages loans in order for the banks to provide additional services or products that might be needed by the customers.

3. Following this rejection, Applicant again amended the claim on April 1, 2004:

1. (Amended) A method of automatically preparing [a] communications [pertaining to] offering one or more financial products or financial services [a financial product or a financial service for an entity], the method comprising:

(1) automatically determining whether to offer a financial product or a financial service to [said] an entity, said entity being from an entity set comprising a plurality of entities, said financial product or said financial service being from a financial product/service set comprising (a), (b), or (c):

(a) one or more financial products;

(b) one or more financial services;

(c) one or more financial products and one or more financial services;

(2) if it is determined to offer [a] said financial product or [a] said financial service to said entity, then [using decision information to] automatically [determine] determining variable information [, the variable information] for inclusion in [the] a communication for said entity; and

(3) automatically generating the communication for said entity if it is determined to offer said financial product or said financial service to said entity, the communication including an offering to said entity for [a] said financial product or [a] said financial service, the communication having a communication format, wherein said

communication format comprises at least one portion that accommodates the variable information, the generating step including incorporating the variable information into said at least one portion of the communication, [wherein the variable information is related to said offering, and] wherein content of said offering in said communication includes the variable information such that said offering comprises variable content, wherein said variable information in said offering at least partially identifies and specifies said financial product or said financial service being offered to said entity [comprises at least one of financial product information, financial service information, offer information, and entity information];

wherein steps (1), (2), and (3) are performed using one or more data processing devices within an automated process; and

wherein steps (1), (2), and (3) are performed for each entity in said entity set and for each financial product and financial service in said financial product/service set, such that each financial product and financial service in said financial product/service set is considered for possible offering to each entity in said entity set [using one or more data processing devices, and are performed within an automated process].

Accordingly, the April 2004 amendment introduced additional language distinguishing the invention over the cited reference, including the limitation noted above as the last element of the claim. Additional arguments were also provided in support thereof, particularly directed to the new claim features:

customer). In contrast, De Lapa does not teach or suggest evaluating each product for possible offer to each customer. De Lapa operates until a customer's coupon sheet is full. Once it is full, De Lapa stops evaluating products for the customer.

4. In yet another non-final Office Action dated October 12, 2004, the PTO again rejected the claim. Notably, however, as is plain from the text below, the Examiner failed to respond, address or provide any evidence pertaining to the new limitation presented in the claims:

**Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-159 are rejected under 35 U.S.C. 103(a) as being unpatentable over De Lapa et al. (5,822,735 hereinafter De Lapa).

With respect to claims 1, 53-58, 64, 116-121, 127-131, 143-148, 150-151, 153, 154-159, De Lapa teaches a method of automatically preparing a communication pertaining to a product for an entity (Abstract). (1)

Automatically determining whether to offer a product to said entity (figure 6);

(2) if it is determined to offer a product to said entity, then using decision information to automatically determine variable information, the variable information in the communication for said entity (see Figures 2 and 6);

(3) and automatically generating the communication, the communication including an offering to said entity for a product, the communication having communication format, wherein said communication format comprises at least one portion that accommodates the variable information, the generating step



including incorporating the variable information into said at least one portion of the communication, wherein the variable information is related to said offering, and wherein the content of said offering in said communication includes variable information such that said offering comprises said variable information in said offering at least partially identifies the product being offered to said entity (see Figure 2).

The steps being performed using data processing devices and within an automated process (i.e. the steps of determining and generating are performed via a computerized system)(see Figure 4).

De Lapa does not specifically teach that the offer is for a financial product or financial service. Official notice is taken that it is old and well known to offer financial products or financial services to customers. For example, bank customers are often offer additional services such as car loans, vacation loans, mortgages loans in order for the banks to provide additional services or products that might be needed by the customers.

As is plainly apparent, there is absolutely no discussion of the new limitation added into the claims. In fact, it appears that the prior rejection was simply copied again, with no accounting made for the changes in the claim.

Consequently it seems abundantly clear that the Examiner did not consider the amendments to the claims. There is nothing in the Office Action, at least, which suggests in any form that there was an evaluation of the new limitations. All indications, in fact, suggest to the contrary.

5. In an amendment dated January 11, 2005, Applicant again amended the claims:

1. (Currently Amended) A method of automatically preparing communications offering one or more financial products or financial services, the method comprising:

(1) automatically determining whether to offer a financial product or a financial service to an entity, said entity being from an entity set comprising a plurality of entities, said financial product or said financial service being from a financial product/service set comprising at least one of (a), (b), [or] and (c):

(a) one or more financial products or one or more plans relating thereto;

(b) one or more financial services or one or more plans relating thereto;

(c) one or more financial products and one or more financial services or one or more plans relating thereto;

(2) if it is determined to offer said financial product or said financial service to said entity, then automatically determining variable information for inclusion in a communication for said entity; and

(3) automatically generating the communication for said entity if it is determined to offer said financial product or said financial service to said entity, the communication including an offering to said entity for said financial product or said financial

service, the communication having a communication format, wherein said communication format comprises at least one portion that accommodates the variable information, the generating step including incorporating the variable information into said at least one portion of the communication, wherein content of said offering in said communication includes the variable information such that said offering comprises variable content, wherein said variable information in said offering at least partially at least one of identifies, [and] specifies, and promotes said financial product or said financial service being offered to said entity, wherein said variable information may vary among persons being offered said financial product or said financial service such that offers of said financial product or said financial service to said persons may vary from person to person;

wherein steps (1), (2), and (3) are performed using one or more data processing devices within an automated process; and

wherein steps (1), (2), and (3) are performed for each entity in said entity set and for each financial product and financial service in said financial product/service set, such that each financial product and financial service in said financial product/service set is considered for possible offering to each entity in said entity set.

Additional arguments were presented to explain how these additional limitations further distinguished over the reference. However, given the clear omission of any proper and sustainable rejection by the Examiner of the limitations of the previous iteration of the claim, Applicant submits that the January 2005 amendments were probably unnecessary. Accordingly, Applicant reserves the right to revise the claims at a later date to better reflect the scope of allowable subject matter in the present application.

6. In May 5, 2005 “final” Office Action, the earlier rejection is repeated, almost verbatim, the rejections made twice before.

Due to the fact that the Examiner’s argument is exactly the same as presented in two prior iterations, it is not reproduced here yet again. An additional response was made to the new limitation in the January 11 amendment, but no mention is provided still concerning the April 1, 2004 amendment.

## **THE PTO HAS FAILED TO MEET ITS BURDEN TO PROVE OBVIOUSNESS WITHIN THE REQUIREMENTS OF § 103 IN THE PRESENT RECORD**

For the reasons explained above Applicant is quite certain the Examiner has not fairly considered the limitations of the pending claims, including the following:

**“...wherein steps (1), (2) and (3) are performed for each entity in said entity set and for each financial product and financial service in said financial product/service set, such that each financial product and financial service in said financial product/service set is considered for possible offering to each entity in said entity set...”** (emphasis added)

As the MPEP points out:

It is important for an examiner to **properly communicate** the basis for a rejection **so that the issues can be identified early and the applicant can be given fair opportunity to reply**. .... Since patent examiners cannot normally be compelled to testify in legal proceedings regarding their mental processes (see MPEP § 1701.01), **it is important that the written record clearly explain the rationale** for decisions made during prosecution of the application. MPEP 706.02(j)

In this case, as noted above the Examiner has clearly not considered one of the limitations of the claims. In an amendment filed April 1, 2004, Applicant amended independent claims 1, 64 and 159 to include the limitation noted above. However, almost a year later the PTO has yet to provide any evidence whatsoever that such limitation is met by the De Lapa reference.

The CFR and MPEP are also clear that the Examiner’s report must be clear and complete on all matters relating to the claims: *See* 37 CFR 1.104 and MPEP 707. “Where a major technical rejection is proper, it should be stated with a full development of reasons rather than by a mere conclusion coupled with some stereotyped expression.” MPEP (

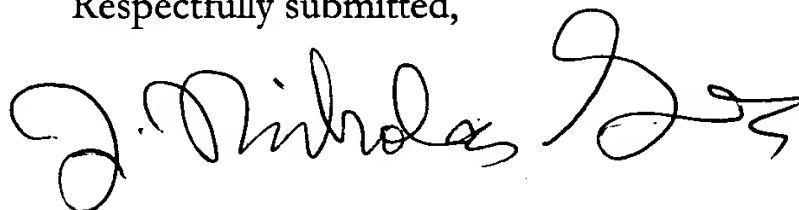
707.07(g). At this point there is nothing in fact on record concerning the Examiner's evaluation of this limitation of the claims.<sup>2</sup> Thus, the PTO has not complied yet with this provision of the CFR, and it is clearly premature to issue a final Office Action.

## CONCLUSION

For the reasons set forth above, Applicant requests that the finality of the Office Action be withdrawn; alternatively, given the existing record, Applicant submits that the claims are clearly patentable, since nothing in the reference has been identified by the Examiner to correspond to the pertinent limitations of the claim.

Should the Examiner wish to discuss this case at any time, please feel free to contact the undersigned. A revocation/new power of attorney has been filed by the applicant in the present case designating the undersigned as attorney of record. A petition and fee for an extension of time is also enclosed. Please charge any fees to deposit account no. 501-244.

Respectfully submitted,



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September 6, 2005  
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I hereby certify that the foregoing is being deposited with the U.S. Postal Service, postage prepaid, to Mail Stop AF, Commissioner for Patents, P.O. Box 1450 Alexandria, VA 22313-1450 this 6<sup>th</sup> day of September 2005.

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<sup>2</sup> It is apparent that a complete lack of evidence cannot meet the criteria needed for a prima facie case of obviousness, and, in that case, the present rejections should be overturned. See e.g., *Rijckaert* 9 F. 3d at 1532; *In re Neilson*, 816 F.2d 1567, 1572, 2 USPQ 2d 1525, 1528 (Fed. Cir. 1984); *In Re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). At a minimum the finality of the Office Action must be withdrawn, as the record is devoid of any rejection by the Examiner of the above limitation.